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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/856,734	05/25/2001	David Bartlett	08364.0019	3454

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EXAMINER

FLANDERS, ANDREW C

ART UNIT PAPER NUMBER

2644

DATE MAILED: 06/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/856,734	BARTLETT ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Andrew C. Flanders	2644	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 10 May 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 61-146 is/are pending in the application.
- 4a) Of the above claim(s) 62-100, 109-114, 116 and 118-138 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 61, 101-108, 115, 117 and 139-146 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |                                                                                                    |                                                                             |
|----------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____                                                |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____                                                                        | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

***Response to Arguments***

Applicant's arguments filed 10 May 2005 have been fully considered but they are not persuasive.

Applicant argues the restriction is improper because "an encoder with spreading means is a special technical feature and according to PCT rule 13.2, the unity of invention requirement will be fulfilled by a group of inventions all of which include the special technical feature of an encoder with spreading means.

However Examiner respectfully disagrees, Rule 13.2 states "The expression 'special technical features' shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art" (see MPEP section 1850 or PCT rule 13.2). As shown in the previous office action dated 25 March 2005 the encoder with spreading means is disclosed by IBM Systems Journal, Vol, 35 Nos. 3 & 4 (i.e. an encoder for outputting a spread signal, page 327 fig 14). As such, the encoder with spreading means when considered with the claim as a whole, does not "make over the prior art" and therefore is not considered a special technical feature. Therefore the restriction stands and accordingly is made final.

Group 5 containing claims 61, 101 – 108, 115, 117 and 139 – 146 will be examined on the merits.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

Art Unit: 2644

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claim 117** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

**Claim 117** recites the limitation "the control signal". There is insufficient antecedent basis for this limitation in the claim. To expedite prosecution the term "the control signal" will be understood as the data signal.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 61, 101, 102, 105, 108, 115, 139, 140, 143 and 146** are rejected under 35 U.S.C. 102(b) as being anticipated by Wolosewicz (U.S. Patent 5,774,452).

Regarding **Claims 61 and 115**, Wolosewicz discloses  
a toy system comprising an encoder for encoding a data signal to form a spread signal (i.e. a device that encodes digital information in the form of labeling information

onto an audio signal using a spread-spectrum signal; col. 18 lines 29 – 30 and col. 18 lines 53 – 54);

an electro-acoustic transducer for converting the spread signal into a corresponding acoustic signal (i.e. the decoder includes audio output jacks which may be connected to a speaker; Fig. 10 and col. 17 lines 1 – 5); and

a toy responsive to the data signal within the spread signal (i.e. the system displays the labeling information after it is decoded; Fig. 9 and col. 13 lines 20 – 24),

wherein the encoder comprises:

(i) means for receiving the data signal (i.e. the desired text is typed into the computer; col. 18 lines 53 – 54);

(ii) means for spreading the received data signal to form a spread signal (i.e. the digital information is encoded using a spread spectrum signal; col. 18 lines 29 – 30);  
and

(iii) output means for outputting the spread signal (i.e. the spread signals are then output to a master DAT, CD or other recording medium; Fig. 14);

and wherein the toy comprises:

(i) an electro-acoustic transducer for receiving and converting the acoustic signal into a corresponding electrical signal (i.e. the decoder includes audio output jacks which may be connected to a speaker; Fig. 10 and col. 17 lines 1 – 5);

(ii) a decoder for de-spreading the electrical signal in order to regenerate the data signal (i.e. Fig. 15 teaches spread-spectrum decoder implemented by the microcomputer which recovers the data signal S; col. 20 lines 1 – 13); and

(iii) response means responsive to the data signal (i.e. the musical selection is shown on the display was detected by the decoder; col. 13 lines 12 – 38).

Regarding **Claims 101 and 139**, in addition to the elements stated above regarding claims 61 and 115, Wolosewicz further discloses:

wherein the response means is operable to generate an output that is discernible to human beings (i.e. the system displays the labeling information after it is decoded; Fig. 9 and col. 13 lines 20 – 24).

Regarding **Claims 102 and 140**, in addition to the elements stated above regarding claims 101 and 139, Wolosewicz further discloses:

wherein the response means is operable to cause the toy to output an acoustic signal determined using the data signal (i.e. the system detects the start of the current list from the data decoded; col. 13 lines 20 – 25)

Regarding **Claims 105 and 143**, in addition to the elements stated above regarding claims 101 and 139, Wolosewicz further discloses wherein the response means is arranged to cause the toy to display a visual signal determined using the data signal (i.e. i.e. the system displays the labeling information after it is decoded; Fig. 9 and col. 13 lines 20 – 24)

Regarding **Claims 108 and 146**, in addition to the elements stated above regarding claims 61 and 115, Wolosewicz further discloses:

means for generating a data signal (i.e. the desired text is typed into a computer; col. 18 lines 54 – 55);

means for spreading the generated data signal to form a spread signal (i.e. the digital information is encoded using a spread spectrum signal; col. 18 lines 29 – 30);  
and

an electro-acoustic transducer for receiving and converting the spread signal into an acoustic signal (i.e. the decoder includes audio output jacks which may be connected to a speaker; Fig. 10 and col. 17 lines 1 – 5);

Claim 117 is rejected under 35 U.S.C. 102(b) as being anticipated by Neubauer (WO97/33391) of which Neubauer (U.S. 6,584,138) is referenced to herein as a translation.

Regarding **Claim 117**, Neubauer discloses a method of transferring data to a domestic appliance (abstract) comprising the steps of:

generating a data signal (i.e. a data signal source; col. 5 lines 29);

spreading the data signal to form a spread signal (i.e. a means for multiplying the pseudo-noise signal by the data signal so as to provide a frequency-spread data signal; col. 5 lines 30 – 33);

generating an acoustic signal conveying the spread signal (i.e. a means for superimposing the audio signal and the weighted data signal in the spectral range; col. 5 lines 36 – 37);

detecting the audio signal at the domestic appliance, converting the acoustic signal into an electrical signal in the domestic appliance and de-spreading the electrical signal in order to regenerate the control signal (i.e. comprising a decoder which extracts the identification signal from the audio signal transmitted; col. 5 lines 40 – 41).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 103, 104, 141, and 142** are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolosewicz (U.S. Patent 5,774,452).

Regarding **Claims 103 and 141**, in addition to the elements stated above regarding claims 102 and 140, Wolosewicz further discloses wherein the response means comprises a processor operable to select one of a plurality of sound files, and to output the selected sound file via an electro-acoustic transducer (i.e. the microcomputer



reads the compressed digital representation of an audio signal associated with the currently displayed label on the display).

Wolosewicz does not explicitly disclose reading the sound files from a memory in the disclosed embodiment. However, Wolosewicz discloses in a separate embodiment storing portions of the audio file in memory (col. 15 lines 11 – 17). It would have been obvious to one of ordinary skill in the art to save the audio files in memory to retrieve them at a later date. Wolosewicz teaches that its encoder can also be used to record audio signals on any medium capable of recording such signals (col. 20 lines 55 – 60). One would have been motivated to have the system retrieve the said files to be able to play back the previously saved files at a later time.

Regarding **Claims 104 and 142**, in addition to the elements stated above regarding claims 103 and 141, Wolosewicz further discloses wherein the memory is detachable (i.e. the memory can include a CD ROM; col. 20 lines 55 – 60).

**Claims 106, 107, 144 and 145** are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolosewicz (U.S. Patent 5,774,452) in view of Satoh (U.S. 5,090,936).

Regarding **Claims 106 and 144**, in addition to the elements stated above regarding claims 101 and 139, Wolosewicz does not disclose wherein the response means is operable to cause a movement of the toy.

Satoh discloses response means operable to cause a movement of the toy (i.e. a moveable decoration that is activated upon a sound of a predetermined level; col. 1 lines 35 – 47).

It would have been obvious to one of ordinary skill to add a moving toy as disclosed by Satoh to a player as disclosed by Wolosewicz. One would have been motivated to do so in order to provide a unique ornamental moving object to accompany the music played by the Wolosewicz device, see further col. 1 lines 18 – 33 of Satoh.

Regarding **Claim 107 and 145**, in addition to the element stated above regarding claims 101 and 139, Wolosewicz does not disclose wherein the response means is operable to cause a movement of part of the toy relative to the rest of the toy.

Satoh discloses response means operable to cause a movement of part of the toy relative to the rest of the toy (i.e. a moveable decoration that is activated upon a sound of a predetermined level; col. 1 lines 35 – 47).

It would have been obvious to one of ordinary skill to add a moving toy as disclosed by Satoh to a player as disclosed by Wolosewicz. One would have been motivated to do so in order to provide a unique ornamental moving object to accompany the music played by the Wolosewicz device, see further col. 1 lines 18 – 33 of Satoh.

### ***Conclusion***


The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Lou (U.S. 6,370,666) and Lou (U.S. 6,876,623).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew C. Flanders whose telephone number is (571) 272-7516. The examiner can normally be reached on M-F 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sinh Tran can be reached on (571) 272-7564. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

acf

  
**SINH TRAN**  
**SUPERVISORY PATENT EXAMINER**